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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/836,145	04/16/2001	Benjamin F. Cravatt	SCRIP1210-3	7817

7590

05/06/2002

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EXAMINER

GARCIA, MAURIE E

ART UNIT

PAPER NUMBER

1627

DATE MAILED: 05/06/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**09/836,145**

Applicant(s)  
**Cravatt et al**

Examiner  
**Maurie E. Garcia, Ph. D.**

Art Unit  
**1627**



— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ONE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☐ Responsive to communication(s) filed on \_\_\_\_\_

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 1-13 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☒ Claims 1-13 are subject to restriction and/or election requirements.

## Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some\* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

20) ☐ Other:

### DETAILED ACTION

**Please Note:** In an effort to enhance communication with our customers and reduce processing time, Group 1627 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-308-4315. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Jyothsna Venkat, Supervisory Patent Examiner, at (703) 308-2439. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

#### *Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-5, drawn to a composition, classified variously, for example, class 435, subclasses 7.4+.
  - II. Claims 6-8, drawn to a compound, classified variously, for example, class 548, subclasses 303.7 or class 568, subclasses 27+.
  - III. Claims 9-11, drawn to a combinatorial chemical library, classified variously, for example, class 435, DIG 22+.
  - IV. Claims 12 and 13, drawn to a method for screening for molecules having an affinity for an active protein, classified variously, for example, class 435, subclass 7.1 or class 435, DIG 2+.
2. The inventions are distinct, each from the other because of the following reasons:
3. Groups I – III represent separate and distinct products. They differ in respect to their properties, their use and the synthetic methodology for making them. Therefore, they have different issues regarding patentability and enablement and represent

patentably distinct subject matter. In the instant case, the library of Group III and the composition of Group I are entities comprising at least two members, while Group II represents distinct compounds. Libraries/compositions and single compounds also have different uses and require different methods of making. Most importantly, each of the products is made of different constituents. The product of Group I contains "at least one covalent product of a target enzyme of a complex protein composition". Neither of the products of Groups II and III require this constituent. Groups II and III represent the difference between a composition comprising at least two members and a single compound. Also, again, the library and single compounds (Groups II and III) differ due to their different uses and different methods of making.

4. Groups I and II are not related to Group IV. The inventions are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects. In the instant case, the method of Group IV is for screening a "combinatorial chemical library" and has no disclosed relationship to the single compounds of Group II or composition of Group I.

5. It is unclear how Group III is related to Group IV. Although Group IV is a method for screening "employing a combinatorial chemical library", it is not clear that the library screened is the same library that is claimed in Group III. This is because in Group III the library is represented by the formula  $R(F-L)-X$ , while in Group IV, the library screened is of the formula  $R^*(F-L)-X$ . These R and  $R^*$  moieties appear to be

different (the libraries would be different in structure). Thus, these groups would not be related. However, if applicant argues that Groups III and IV are related as product and process of use, the following is noted. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the library of Group III could be used in another method of use such as a starting material for further synthesis of other libraries.

6. These inventions have acquired a separate status in the art as shown by their different classification and/or divergent subject matter. The different products and method would require completely different searches in both the patent and non-patent literature databases, and there is no expectation that the searches would be coextensive. Therefore, this does create an undue search burden, and restriction for examination purposes as indicated is proper.

7. This application contains claims directed to patentably distinct species of the claimed invention for **Groups I – IV**. Election is required as follows.

8. If applicant elects the invention of **Group I**, applicant is required to elect from the following patentably distinct species. Please elect one species from *each* subgroup below. Claim 1 is generic.

Species of composition

Applicant is required to elect, for purposes of search, a single specific composition. The election should result in a *particularly defined* composition, showing both the “covalent product of a target enzyme of a complex protein composition” and the “activity based probe member” *by structure*. All variable groups should be defined (i.e. all atoms and bonds shown).

Species of target enzyme

Applicant is required to elect, for purposes of search, the *specific* type of target enzyme.

The species are distinct, each from the other, because their structures and modes of action are different. They would also differ in their reactivity and the starting materials from which they are made. Therefore, the species have different issues regarding patentability and represent patentably distinct subject matter.

9. If applicant elects the invention of **Group II**, applicant is required to elect from the following patentably distinct species. Claim 6 is generic.

Species of compound

Applicant is required to elect, for purposes of search, a single specific compound. The election should result in a *particularly defined* compound. All variable groups should be defined (i.e. all atoms and bonds shown).

The species are distinct, each from the other, because their structures and modes of action are different. They would also differ in their reactivity and the starting materials from which they are made. Therefore, the species have different issues regarding patentability and represent patentably distinct subject matter.

10. If applicant elects the invention of **Group III**, applicant is required to elect from the following patentably distinct species. Claim 8 is generic.

Species of library

Applicant is required to elect, for purposes of search, a single specific library. The election should result in a *particularly defined* core structure that is shared by all library members. In defining this core structure, all variable groups should be defined (i.e. all atoms and bonds shown) as much as possible.

The species are distinct, each from the other, because their structures and modes of action are different. They would also differ in their reactivity and the starting materials from which they are made. Therefore, the species have different issues regarding patentability and represent patentably distinct subject matter.

11. If applicant elects the invention of **Group IV**, applicant is required to elect from the following patentably distinct species. Claim 12 is generic.

Species of library screened

Applicant is required to elect, for purposes of search, a single specific library that is screened in the claimed method. The election should result in a particularly defined core structure that is shared by all library members. In defining this core structure, all variable groups should be defined (i.e. all atoms and bonds shown) as much as possible.

The species are distinct, each from the other, because their structures and modes of action are different. They would also differ in their reactivity and the starting materials from which they are made. Therefore, the species have different issues regarding patentability and represent patentably distinct subject matter.

12. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

13. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.



14. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

15. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

16. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143). Because the above restriction/election requirement is complex, a telephone call to applicants to request an oral election was not made. See MPEP § 812.01.

17. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

18. Applicant is also reminded that a 1 - month (not less than 30 days) shortened statutory period will be set for response when a written requirement is made without an action on the merits. This period may be extended under the provisions of 37 CFR 1.136(a). Such action will not be an "action on the merits" for purposes of the second action final program, see MPEP 809.02(a).

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maurie E. Garcia, Ph.D. whose telephone number is (703) 308-0065. The examiner can normally be reached on Monday-Thursday from 9:30 to 7:00 and alternate Fridays.

20. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jyothsna Venkat, can be reached on (703) 308-2439. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Maurie E. Garcia, Ph.D.  
May 3, 2002



MAURIE E. GARCIA, PH.D.  
PATENT EXAMINER



# RESTRICTION ELECTION FACSIMILE TRANSMISSION

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TO EXAMINER: Maurie E. Garcia, Ph.D.

ART UNIT: 1627

SERIAL NUMBER:

FAX/TELECOPIER NUMBER: (703) 308-4315

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